

Applicants: Luc Farmer et al.
Application No.: 10/809,944

REMARKS

The Claim Amendments

Applicants have amended claims 1, 10-13, 17, 23, 27-28, and 34 to correspond the claims to elected group I.

Claim 1 has been amended such that the definition of Z is further clarified. Support for this amendment is found in [0049] on page 17. Further, claim 1 has been amended to define R^4 as hydrogen. Support for these amendments is found in [0052] on page 18. As a consequence of this amendment, the proviso in claim 1 has been deleted and claims 12-14 and 36 have been amended to correspond these claims to a compound of formula I, wherein R^4 is hydrogen.

Claim 1 has also been amended such that two adjacent occurrences of $Q-R^5$, taken together with the atoms to which they are bound, can form an optionally substituted saturated, partially unsaturated, or fully unsaturated 5-8-membered ring having 0-3 heteroatoms selected from nitrogen, oxygen, or sulfur. Support for this amendment is found in [0043] on page 14.

Claim 7 has been amended such that the alternative embodiment of Q being a bond is no longer recited. Support for this amendment is found in the claim as originally filed and the corresponding specification text.

Claim 10 has been amended to delete the alternative embodiment wherein R^1 or R^2 can be TR. Support for this amendment finds support in the claims as originally filed and in the corresponding specification text.

Claim 12 has been amended to include the term "Z is a bond or" and replace the term " C_{0-4} alkylidene chain" with " C_{1-4} alkylidene chain." Further, claim 29 has been amended to replace the term " C_{0-4} alkylidene chain" with " C_{1-4} alkylidene chain." These amendments improve claim form or remove redundant claim elements and find support in [0072] on page 27 of the specification.

Claim 14 has been amended such that n and m are defined. Support for this amendment is found in [0053] on page 18. Further, claims 14 and 30 have been amended to delete the alternative embodiments wherein R^3 is aralkyl or heteroaralkyl.

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Support for these amendments is found in the claims as originally filed and the corresponding specification text.

Claims 17 and 23 have been amended such that the formulae of the claim are clearly identified. Support for these amendments is found in the claims as originally filed and the corresponding specification text.

Claim 20 has been amended to improve its form.

Claim 40 has been amended such that the claim recites a method of inhibiting kinase activity in a biological sample. Support for this amendment is found in the claim as originally filed and the corresponding specification text.

Claims 41 and 43 have been amended to recite diseases treated by the claimed methods. Support for these amendments is found in [00123]-[00130] on pages 50-51.

Claim 42 has been amended to improve its form.

None of the amendments contain new matter. Their entry is requested.

The Restriction

The Examiner has required a restriction in the above-identified application under 35 U.S.C. § 121 to one of the following two groups:

I. Claims 1-44, drawn to compounds of formula I, wherein R^1 and R^2 are independent substituents and are NOT taken together to form a ring, corresponding composition and method of use; and

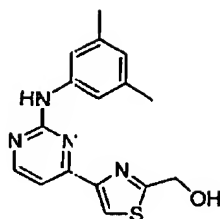
II. Claims 1-35 and 37-44, drawn to compounds of formula I, wherein R^1 and R^2 are taken together to form a ring, corresponding composition and method of use.

Applicants elect Group I without traverse.

The Election of Species

The Examiner has required an election of species under 35 U.S.C. § 121. Applicants elect species I-4 with traverse. Compound I-4 has the following structure:

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Claims 1-12, 14, 17-28, 30, 34, and 36-44 read on the elected species.

Applicants traverse because it appears that the Examiner is making a restriction requirement for each species encompassed by the elected invention, even though the requirement is phrased as an election of species. Under 37 CFR § 1.141(a), more than one species of an invention may be specifically claimed in an application provided that the application also includes an allowable generic claim to all claimed species.

In the instant application, (i) each claimed species falls within the scope of generic formula I of claim 1, and (ii) the number of species claimed is not unreasonable and would not constitute an undue search burden on the Examiner.² In addition, a restriction based upon a single species would prevent Applicants from properly claiming their invention (see MPEP § 803.02). The instant invention encompasses all species defined in the claims, including certain species that have not been exemplified in the specification. Thus, a restriction requirement that requires election of a single disclosed species would prevent Applicants from claiming those aspects of their invention for species that are encompassed by the generic claims but are not specifically disclosed. For these reasons, Applicants respectfully request that the Examiner withdraw the restriction requirement as it relates to an election of species.

² A search of the entire subject matter of groups I and II claimed in the corresponding PCT application has been conducted by the European Patent Office, as indicated in the International Search Report submitted with the Information Disclosure Statement filed on August 31, 2005 for the instant application. Two references of particular relevance were cited in the Search Report.

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The elections made herein are made expressly without waiver of applicants' rights to continue to prosecute and to obtain claims to the non-elected subject matter either in this application or in other applications claiming benefit herefrom.

Conclusion

Applicants request that the Examiner enter the above amendments, consider the accompanying arguments, and allow the claims to pass to issue. Should the Examiner deem expedient a telephone discussion to further the prosecution of the above application, applicants request that the Examiner contact the undersigned at his convenience.

Respectfully submitted,



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